

REMARKS

The priority of the application, the foreign priority claim in the application, and the specification stand objected for the claimed term “colorless” allegedly being new matter. Particularly, the Action correctly notes that the Board decision of September 16, 2003, in parent application No. 09/532,966 determined that the parent specification did not support this terminology. However, that same opinion of the Board noted that the appellants had not provided evidence in support of their contention that the specification provided written support for the term “colorless,” and asserted that mere attorney argument is insufficient to overcome the Examiner’s *prima facie* showing that the claims are unpatentable under 35 U.S.C. § 112, first paragraph.

Attached hereto is a Declaration and accompanying attachments establishing that the present specification inherently provides support for the term “colorless.” Consequently, unlike the situation of the parent application, there is now evidence in the record establishing that the present specification would convey to one of ordinary skill in the art written support for the term “colorless.”

Therefore, applicants respectfully submit that the present application is a proper continuation of parent application No. 09/532,966, and as such, the present application should be accorded the effective filing date of that application, namely March 22, 2000, as well as foreign priority to DE 19913227.5-27 filed March 23, 1999. See M.P.E.P. § 201.13 at pages 200-67.

Moreover, applicants have amended the first paragraph in the specification to claim priority to parent application No. 09/532,966 filed March 22, 2000. Nonetheless, applicants respectfully submit that claiming priority to application No. 10/287,596 (improperly cited as App. No. 09/287,596), filed November 5, 2002, now U.S. Patent No. 6,667,260, in turn a

continuation of U.S. Patent Application Serial No. 09/532,966, is proper. However, applicants have deleted this latter priority claim to expedite the examination of the application. However, this deletion should not be construed as acquiescence to this ground of objection.

In summary, applicants respectfully submit that the objections to the claimed priorities and specification should be withdrawn.

Claim Rejections Under 35 U.S.C. § 102

Claims 5, 8 and 9 stand rejected as allegedly being anticipated by U.S. Patent No. 5,288,668 (Netter). With respect to claim 5, applicants respectfully submit that the attached Declaration establishes that the manganese oxide of Netter is a colorant, not a decolorant. As discussed above, this evidence was not before the Board in deciding the appeal in the parent application. Thus, applicants respectfully submit that Netter does not anticipate the invention as defined by claim 5.

With respect to the terminology “consisting essentially of” in claim 8, applicants respectfully submit that this terminology excludes materials that would materially affect the basic and novel characteristics of the claimed glass. With respect to Netter, Netter exemplifies using some amounts of MnO₂. The Declaration provides evidence that MnO₂ in such amounts used in Netter acts as a colorant, and as such, would affect the basic and novel characteristics of the glass as defined by claim 8. Consequently, applicants respectfully submit that claim 8 defines over Netter in view of this newly-submitted evidence.

Claims 1–21 stand rejected as allegedly being anticipated by GB 2348197 (GB) and Japanese document 2000-290037 (JP). Applicants respectfully submit that the present application has a effective filing date of the parent application No. 09/532,966, filed

March 22, 2000, as discussed above. Consequently, applicants respectfully submit that these rejections should be withdrawn.

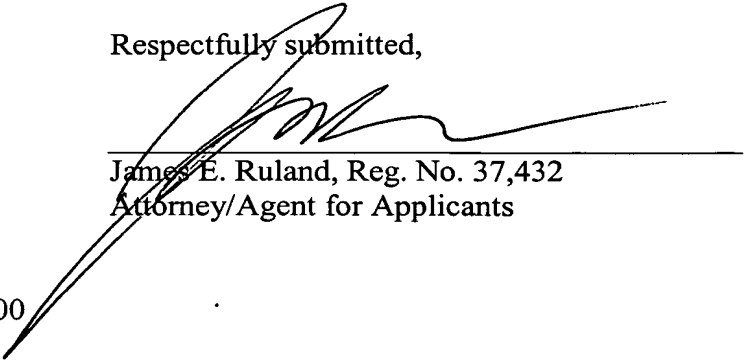
Double-Patenting

Claims 1-21 stand rejected under the judicially-created doctrine of obviousness-type double-patenting as allegedly being unpatentable over claims 1-12 of U.S. Patent No. 6,667,260. Attached hereto is a Terminal Disclaimer removing these rejections. The filing of this Terminal Disclaimer should be in no way construed as acquiescence to any of these rejections. Consequently, applicants respectfully submit that these rejections should be withdrawn.

In view of the above, favorable reconsideration is courteously requested. If there are any remaining issues which can be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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